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09/635,935	08/10/2000	Devon A. Rolf	RFDV.68391	6337

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UNEEDA ROYER
11924 E. 57TH STREET
KANSAS CITY, MO 64133

EXAMINER

HARLE, JENNIFER I

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 04/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/635,935

Applicant(s)

ROLF, DEVON A.

Examiner

Jennifer I. Harle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/10/00.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-3 are pending. Claims 1-3 are rejected.

Lexicography

After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant(s) to be their own lexicographer and to define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).¹

In accordance with the ordinary and accustom meaning presumption, during examination the claims are interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).²

However, if Applicant(s) wish to use lexicography and desire a claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests

¹ It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

² See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

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Applicant(s) in their next response to expressly indicate³ the claim limitation at issue⁴ and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).⁵ The Examiner cautions that no new matter is allowed.

Failure by Applicant(s) in their next response to address this issue or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) to forgo lexicography in this application and to continue having the claims interpreted with their ordinary and accustomed meaning and with their broadest reasonable interpretation. Additionally, it is the Examiner’s position that above requirements are reasonable.⁶ Applicant(s) are also cautioned that even

³ “Absent an *express intent* to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. [Emphasis added.]” *Wenger Manufacturing Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1232, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001) (citations and quotations omitted). “In the absence of an *express intent* to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning. We indulge a heavy presumption that a claim term carries its ordinary and customary meaning. [Emphasis added.]” *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (citations and quotations omitted).

⁴ “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁵ See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.02, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

⁶ The requirements are reasonable on at least two separate and independent grounds: first, the Examiner’s requirements are simply an express request for clarification of how Applicant(s) intend their claims to be interpreted. Second, the requirements are reasonable in view of the USPTO’s goals of compact prosecution, productivity with

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though claim interpretation begins with this presumption, after issuance the prosecution history may further limit claim scope if Applicant(s) disclaim or disavow a particular interpretation of the claims during prosecution. *Abbott Laboratories v. TorPharm Inc.*, 300 F.3d 1367, 1372, 63 USPQ2d 1929, 1931 (Fed. Cir. 2002). Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles apply to all examined claims currently pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites two processors, one in line 2 and another in line 8. It is unclear if these are two different processors, i.e. each associated with a different device or whether they are the same processor.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Ausems, et al. (6,424,403 B1).

As per claim 1, Ausems teaches a system comprising:

A portable, wireless voice and data communications device⁷ having a memory and a transmitter, wherein said memory has data indicative of monetary units stored therein (Figs. 2-3; Abstract, cols. 5-6, lines 48-59, col. 7, lines 21-31, cols. 7-8, lines 53-6))⁸; and

A point of sale terminal at which sales are made, wherein data indicative of a selected amount of monetary units associated with a sale are transmitted from said memory to said point of sale terminal or an associated processor to make said sale (Figs. 2-3; Abstract; col. 1, lines 54-65, col. 6, lines 19-44, col. 7, lines 21-31)⁹.

As per claim 2, Ausems teaches a device comprising:

A processor (Figs. 2-3; col. 6, lines 19-44, cols. 7-8, lines 52-7)¹⁰;

A transmitter connected to said processor for transmitting wireless communication signals (Figs. 2-3; Abstract, cols. 5-6, lines 48-59, cols. 7, lines 21-31, cols. 7-8, lines 53-6)¹¹; and

⁷ The portable, wireless voice and data communication device is the single integrated device taught by the patent, which combines a wireless telephone, smart-card engine and PDA, as set forth in the Abstract and more specifically in the patent.

⁸ The memory holding the financial data is part of both the PDA and the smart-card chips. It is noted that that the smart cards can be housed as part of the device or that the smart-card engine may include the chips only, thus obviating the need for external smart cards. The transmitter is part of the wireless telephone operations engine and is also part of the smart card engine.

⁹ The memory holding the financial data is interconnected, i.e. from the smart card engines/chips and the PDA engine/memory. Data indicative of monetary units is transmitted to either a POS or an associated processor via any one of the engines as set forth.

¹⁰ The PDA engine contains a CPU which processes information received at the PDA engine, including POS information. Additionally, it is inherent/implicit that a POS system would have a processor as by definition they are computerized transaction systems used to record purchases and as set forth in the reference information is being transmitted back and forth between the two devices in order for purchases to occur. The processor is the device that interprets and executes instructions without it, a POS or other computerized sale device that communicated with the wireless device could not function.

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A memory connected to said processor, wherein said memory has stored therein data indicative of an account to or against which transactions are accounted, and wherein said device is adapted to wirelessly communicate with at least one of a terminal and a processor associated with said terminal via a wireless communications link for the purposes of transacting a sale, and wherein data indicative of said account is transmitted via said transmitter to said remote terminal as part of said sales transaction (Figs. 2-3; Abstract, cols. 1-2, lines 54-4, col. 4, lines 43-60, cols. 5-6, lines 48-59, col. 7, lines 17-31, cols. 7-8, lines 53-6).¹²

As per claim 3, Ausems teaches a method of transacting a sale at a point of sale terminal, said method comprising (cols. 5-6, lines 48-59):

Providing a communications device having an input (col. 4, lines 40-62; cols. 5-6, lines 48-59);

Providing a plurality of accounts associated with said device or a user of said device (col. 4, lines 47-57, col. 6, lines 29-31); and

Using said input to select one of said accounts for associating with said sale to be transacted (col. 4, lines 40-62; cols. 5-6, lines 48-59).¹³

¹¹ The transmitter is connected to both processors in the reference. It is connected to processor in the wireless device to transmit the initial and any additional required signals to the POS. The transmitter is also connected to the processor of the POS because it is capable of receiving information from the POS and downloading it. Thus, either way the claim is interpreted, the limitation is met.

¹² See footnotes 7-11 for a full explanation of these limitations.

¹³ See footnotes 7-11 for a full explanation of the limitations. Note that the input described would be either by inputting the card into the slot, as specifically described or by utilizing the touch screen as implicitly set forth. It is implicit because if there is no need of external smart cards as only the chip(s) are used, then there must be a mechanism to select credit or cash, and which account is being utilized, without inputting the card. Thus, the display implicitly must be utilized as it is linked to all the information and is utilized to transmit the information to the POS. Either way, the limitation is met.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Global Mobility Systems, Inc. – System and Method for Controlling Financial Transactions Over a Wireless Network – WO 99/33034 (1 July 1999) teaches a system and method for controlling financial transactions using a wireless devices, which identifies a point of sale device.

Swiss-Com AG – Transaction Method Carried Out with a Mobile Apparatus – WO 99/00773 (7 January 1999) teaches a method for carrying out financial trans with a mobile phone and an electronic terminal, wherein an electronic sum of money can be memorized.

Ohki, et al. – Telephone Used for Electronic Money Card Transaction and Method of Operation of the Same – US 6,339,638 B1 (Jan. 15, 2002) teaches a telephone for transferring electronic money between money cards and person to retailer transactions based on electronic money cards.

Serbetciougiu, et al. – Short Message Transaction Handling System – 5,719,918 (Feb. 17, 1998) teaches a transaction handling system for use in a cellular phone, which utilizes information from credit cards, smart cards, etc. and queries a database, including POS systems.

Teicher – Countable Electronic Monetary System and Method – 6,119, 946 (Sep. 19, 2000) teaches smart card payment system with a POS interface through and EC-O purse.

Maes, et al. – Portable Information and Transaction Processing System and method Utilizing Biometric Authorization and Digital Certificate Security – 6,016,476 (Jan. 18, 2000) teaches a portable PDA with user interface, local CPU, memory for storing financial information,

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I/O capability for reading smartcards, magnetic cards, and can be downloaded to perform consumer transactions with POSs.

Schilling – Wireless Debit Card System and Method – 6,170,745 (Jan. 9, 2001) teaches a wireless debit card communication system including a radio telephone which may be connected to a debit meter.

Reccia, et al. – Secure, Stored-value Systems and Methods of Transferring Monetary Values in One or More Transactions to a Specific Receiving Device – 6,039,247 (Mar. 21, 2000) teaches methods and systems for encoding and decoding monetary values onto memory in wireless telephones and includes POS devices.

Anderson – Personal Intercommunication Purchase and Fulfillment System – 5,857,156 (Jan. 5, 1999) teaches purchasing items by entering a code into a pager.

In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, and because "the continual, chief complaint of inventors and their lawyers: that patent examiners are abysmal communicators, both orally and in writing,"¹⁴ the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant(s) with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant(s) disagree with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹⁵ the Examiner respectfully requests Applicant(s) *in their next response* to expressly

¹⁴ Sabra Chartrand, *A Bid to Overcome Patent Backlogs*, 152 N.Y. Times C2 (Sept. 23, 2002).

¹⁵ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

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traverse the Examiner's position and provide appropriate arguments in support thereof. Failure by Applicant(s) *in their next response* to traverse the Examiner's positions and provide appropriate arguments in support thereof will be considered an admission by Applicant(s) of the factual determinations and legal conclusion not expressly traversed.¹⁶ By addressing these issues now, matters where the Examiner and Applicant(s) agree can be eliminated allowing the Examiner and Applicant(s) to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is (703) 306-2906. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Jennifer Ione Harle
April 18, 2003


Richard Chilcot
Acting Supervisory Patent Examiner
Technology Center 286
JCH

¹⁶ See also MPEP §714.02, 37 CFR §1.111(b), and 37 CFR §1.104(c)(3).